

IN THE SPECIFICATION:

Please replace the paragraph beginning at page 11, line 3, with the following rewritten paragraph:

FIG. 16 illustrates that in a preferred embodiment the distance (A) between the smoking material receptacle opening and the pipe receptacle opening in the body is greater than ~~depth~~ width (B) of the body and the like ~~depth~~ width of the lid at the pivot point. If B were greater than A, portions of the smoking material receptacle opening 3 and the pipe receptacle opening 4 would still be covered when the lid is rotated ninety degrees to an open position. It is seen, therefore, that the pipe receptacle opening is a distance from the smoking material receptacle opening, which distance is greater than the lid ~~depth~~ width. This feature provides unobstructed access to the smoking material receptacle opening and pipe receptacle opening upon rotation of the lid to an open position.

IN THE CLAIMS:

Claim 1. (Previously amended) A compact wooden smoking apparatus comprising:

a smoking apparatus body having a body top, a body bottom, and body external side walls;

5 wherein the body has a constant peripheral contour in cross sections taken in any plane generally parallel to the body top and body bottom;

a smoking material receptacle in the body having a smoking material receptacle opening at the body top;

10 a pipe receptacle separate from the smoking material receptacle; and

a lid for the smoking material receptacle, the lid having a lid top, a lid bottom, a lid width, lid depth, and lid external walls;

15 wherein the lid has a constant peripheral contour in cross sections taken in any plane generally parallel to the lid top and lid bottom.

Claim 2. (currently amended) The compact wooden smoking apparatus of claim \pm 9 wherein the constant peripheral contour of the lid corresponds to the constant peripheral contour of the body, such that when the lid bottom is applied to the body top,
5 the lid and body are alignable as the compact smoking apparatus, which apparatus has a constant peripheral contour in cross sections taken in any plane generally parallel to the lid top and body bottom.

Claim 3. (original) The compact wooden smoking apparatus of claim 2 wherein the lid is pivotably attached to the body.

Claim 4. (original) The compact wooden smoking apparatus of claim 3 wherein the lid is attached to the body by means of a metal fastener.

Claim 5. (original) The compact wooden smoking apparatus of claim 4 wherein the metal fastener is a pan head washer type screw.

Claim 6. (original) The compact wooden smoking apparatus of claim 2 wherein the lid and body each have wood grain which runs in the same direction when the lid is applied to the body.

Claim 7. (original) The compact wooden smoking apparatus of claim 2 wherein the lid and body are manufactured from a single piece of wood.

Claim 8. (original) The compact wooden smoking apparatus of claim 7 wherein the lid and body are manufactured from adjacent segments of the single piece of wood such that the lid has a wood grain which matches a wood grain of the body.

Claim 9. (currently amended) ~~The compact wooden smoking apparatus of claim 1 comprising:~~

A compact wooden smoking apparatus comprising:

a smoking apparatus body having a body top, a body bottom,
5 and body external side walls;

wherein the body has a constant peripheral contour in cross sections taken in any plane generally parallel to the body top and body bottom;

10 a smoking material receptacle in the body having a smoking material receptacle opening at the body top;

a pipe receptacle separate from the smoking material receptacle ~~the pipe receptacle in the body~~ having a pipe receptacle opening at the body top; and

15 a lid for the smoking material receptacle, the lid having a lid top, a lid bottom, a lid width, lid depth, and lid external walls;

wherein the lid has a constant peripheral contour in cross sections taken in any plane generally parallel to the lid top and lid bottom;

20 wherein the lid is pivotably attached to the smoking apparatus body; and

 wherein the pipe receptacle opening is a distance from the smoking material receptacle opening, which distance is greater than the lid ~~depth~~ width to thereby provide unobstructed access
25 to the smoking material receptacle opening and pipe receptacle opening simultaneously upon rotation of the lid to an open position.

Claim 10. (original) The compact wooden smoking apparatus of claim 9 wherein:

 the smoking apparatus side walls have a generally arcuate contour having a contour radius dimension;

5 the smoking material receptacle opening has an arcuate section at a point closest to a center point of the smoking apparatus body, and has a smoking material receptacle radius dimension corresponding to said arcuate section; and

 the contour radius dimension is greater than the smoking
10 material receptacle radius dimension.

Claim 11. (currently amended) A compact wooden smoking apparatus comprising:

a smoking apparatus body having a body top, a body bottom, and body external side walls;

5 wherein the body has a constant peripheral contour in cross sections taken in any plane generally parallel to the body top and body bottom;

a smoking material receptacle in the body having a smoking material receptacle opening at the body top;

10 a pipe receptacle separate from the smoking material receptacle; and

a lid for the smoking material receptacle, the lid having a lid top, a lid bottom, a lid width, lid depth, and lid external walls;

15 wherein the lid has a constant peripheral contour in cross sections taken in any plane generally parallel to the lid top and lid bottom; and

~~The compact wooden smoking apparatus of claim 1 comprising a~~
replacement lid section extending upwardly from the smoking
20 apparatus body bottom, the replacement lid section having a
constant peripheral contour in cross sections generally parallel
to its top and bottom, which constant peripheral contour
corresponds to the constant peripheral contour of the body, such
that when the replacement lid is attached to the body, the lid
25 and body are alignable such that the compact smoking apparatus
including body and replacement lid section has a constant
peripheral contour in cross sections from the body top through
the replacement lid.

Claim 12. (original) The compact wooden smoking apparatus of claim 2 comprising a contour having a uniform depth and uniform width formed by the removal of wood and extending from the top of the lid to the bottom of the body bottom.

Claim 13. (original) The compact wooden smoking apparatus of claim 12 wherein the contour has a generally arcuate shape.

Claim 14. (currently amended) A compact wooden smoking apparatus comprising:

a smoking apparatus body having a body top, a body bottom, and body external side walls;

5 wherein the body has a constant peripheral contour in cross sections taken in any plane generally parallel to the top and bottom of the body;

a smoking material receptacle in the body having a smoking material receptacle opening at the body top;

10 a pipe receptacle separate from the smoking material receptacle having a pipe receptacle opening at the body top; and
a lid for the smoking material receptacle, the lid being pivotably attached to the body top;

15 wherein the pipe receptacle opening is a distance from the smoking material receptacle opening, which distance is greater than the lid width to thereby provide unobstructed access to the smoking material receptacle opening and pipe receptacle opening simultaneously upon rotation of the lid to an open position.

REMARKS

The undersigned acknowledges discussing this case with Examiner Lopez by telephone on August 11, 2003.

Reconsideration is requested of the rejection of claim 5 under section 112. The phrase "pan head washer type screw" is used in the specification at page 13, line 22. The "pan head" modifier acts to sufficiently identify the washer type screw to be used and the scope of claim 5. This is a definitive piece of hardware and leaves no question in the mind of one skilled in the art as to the type of hardware encompassed.

With regard to claim 1, the undersigned and the Examiner had reached an agreement in their telephone conversation that applicant would delete it. However, in the time since discussing this case with the Examiner on August 11, the undersigned has located further information supporting the conclusion that Hill does not reasonably disclose to one skilled in the art a second embodiment which lacks a third (frontal) recess. Applicant therefore respectfully requests further brief consideration of this issue. In particular, Hill's claim 3 depends from Hill's claim 2 and refers to "the second and third recesses" (Col. 6, ln. 38) without antecedent basis for the "third recess" in claim 3. Accordingly, claim 3 appears to have been drafted with the understanding that there was "a third recess" in claim 2. Likewise, claim 4 depends from claim 2 and refers to "the third recess" (Col. 6, ln. 46) without antecedent basis for the "third recess" in claim 4. It appears that claim 4 was similarly drafted with the understanding again that "the third recess" was in claim 2. Claims 3 and 4 further indicate that one skilled in the art reading Hill not would be struck with any thought such as "Hill discloses an embodiment with no front recess." Moreover,

independent claims are drafted to recite only the points of novelty; they are not drafted to recite every feature of the invention. Accordingly, that claim 2 (and the rephrasing of claim 2 in column 3) lacks a feature such as the front recess only indicates Hill did not think his front recess was required for novelty. In view of these facts, in combination with the facts that a) all of Hill's figures show a third recess; b) Hill's "Description" describes only embodiments with a third recess; and c) Hill's column 3, lines 18-32 in the summary is simply a procedural summary of claim 2 and cannot fairly be taken to be describing a distinct embodiment not described in the "Description," applicant respectfully requests further reconsideration of applicant's claim 1.

The central issue here is what would one skilled in the art learn from Hill. With all due respect, the conclusion asserted by the PTO in this regard is a hyper-literal reading of the reference which flies in the face of the fair, practical teaching of Hill. MPEP 2142.02 and fundamental fairness require that the reference must be viewed "as a whole" for what it fairly teaches to one of ordinary skill in the art. Applicant respectfully submits that Hill only teaches an embodiment having a front recess. In the event the Examiner is not persuaded, he is asked to telephone the undersigned. In the interest of expediting prosecution, the undersigned is authorized to resolve this matter by deletion of claim 1 as was discussed in the August 11 telephone interview.

Reconsideration is requested of the rejection of claims 2-10, and 12-14 over Hill. Applicant's claim 9 has been amended as an independent claim, and has an affirmative requirement that the pivotable lid is attached to the smoking apparatus' body in a

manner such that "the pipe receptacle opening is a distance from the smoking material receptacle opening, which distance is greater than the lid width." Such a configuration provides "unobstructed access to the smoking material receptacle opening and pipe receptacle opening simultaneously upon rotation of the lid to an open position." Support for this amendment can be found in the specification explicitly at page 11, lines 3-16, and implicitly, for example, at page 10, lines 5-18. Hill does not show or teach a requirement that the distance between the first and second recess be greater than the cover plate's width. From the various positions shown in phantom in Hill's Fig. 2, it is evident that Hill's lid does not provide unobstructed access to both the first recess (pipe receptacle) and the second recess (smoking material receptacle) simultaneously. Claim 9 is therefore patentable over Hill because Hill teaches away from such a configuration.

Claim 2, as amended, depends from claim 9 and is patentable for the same reasons as claim 9.

Claims 3-8, 12, and 13 depend from claim 2 or claims depending therefrom and are patentable for the same reasons as claim 9.

Claim 10 depends from claim 9 and is patentable for the same reasons as claim 9.

Claim 11 has been amended to be an independent claim. In the previous Office action of February 5, 2003, claim 11 was stated to be allowable if amended so as to not depend from a rejected base claim. The above amendment places this claim in allowable form.

RCP 6014
PATENT

Claim 14 has been amended to incorporate the requirements of original claim 9 and is therefore patentable for the same reasons as claim 9.

In view of the foregoing, applicant respectfully requests issuance of a Notice of Allowance for claims 1-14.

Respectfully submitted,



Paul I. J. Fleischut, Reg. No. 35,513
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

PIF/leb

Express Mail No. EV 890684444 US